

Remarks

I. Claims 1-3 and 5-7 Rejection -- 35 USC §103. Claims 1-3 and 5-7 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Bowden* (884,702) in view of *Hautier* (3,787,066). This rejection is traversed. In addition, (i) claim 1 is currently amended to include a final “wherein” clause that emphasizes the patentable differences, (ii) currently presented independent claim 8 is added using language that differs from claim 1 in the final paragraph and that includes a bearing component (e.g., as recited in claim 2), and (iii) currently presented dependent claims 9-13 are added (restatements of claims 3-7 that are made dependent on claim 8).

Overview. The instant invention includes a free-wheeling spinner component 14 mounted rotatably within a wheel 10. The spinner component 14 is mounted rotatably (e.g., with a bearing component 13) so that the spinner component 14 free wheels relative to the wheel 10. When the wheel 10 rotates, friction of the bearing component 13 causes the spinner component 14 to rotate (i.e., spin) until the angular speed of the spinner component 14 approaches the angular speed of the wheel 10. When the wheel 10 stops, the spinner component 14 continues to spin by action of the bearing component 13, until friction of the bearing component 13 eventually causes the spinner component 14 to stop.

Hautier (3,787,066) includes much different and more complicated structure designed for wheel-stabilizing purposes. *Hautier* includes a disc 1 mounted rotatably within a wheel. The disc 1 is rigidly secured to a tube 2 that is mounted with ball bearings 3 and 4 on the wheel axle 5. A pulley 10 is fixed to the tube 2 and another pulley 15 is provided that drives the pulley 10 through a set of belts. Additional pulleys and

associated components are provided that result in the disc 1 rotating faster than the wheel (col. 2, lines 56-62).

Adding a *Hautier* disc 1 and associated components to the *Bowden* wheel would result in a stabilizing structure as described in *Hautier*. However, it would not result in the free-wheeling spinner component 14 of the instant invention as specified in the amended claims. Currently amended claim 1 specifies "wherein the spinner component is not driven by a pulley component." To get the disc 1 to spin and free-wheel like the free-wheeling spinner component 14 of the instant invention would require removal of the pulley 10 and associated drive components. In other words, it would require modification away from the teaching of the *Hautier* disclosure, and so there is no incentive or teaching to make the required modification. Thus, the combination of *Hautier* and *Bowden* does not serve as a basis for rejection.

Important portions of MPEP §2143.01 addressing this issue follow for references purposes:

THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." In *re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In *re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT
SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART
UNSATISFACTORY FOR ITS INTENDED PURPOSE

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) (Claimed device was a blood filter assembly for use during medical procedures wherein both the inlet and outlet for the blood were located at the bottom end of the filter assembly, and wherein a gas vent was present at the top of the filter assembly. The prior art reference taught a liquid strainer for removing dirt and water from gasoline and other light oils wherein the inlet and outlet were at the top of the device, and wherein a pet-cock (stopcock) was located at the bottom of the device for

periodically removing the collected dirt and water. The reference further taught that the separation is assisted by gravity. The Board concluded the claims were prima facie obvious, reasoning that it would have been obvious to turn the reference device upside down. The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.).

THE PROPOSED MODIFICATION CANNOT CHANGE THE PRINCIPLE OF OPERATION OF A REFERENCE

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. In *re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959) (Claims were directed to an oil seal comprising a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references disclosed an oil seal wherein the bore engaging portion was reinforced by a cylindrical sheet metal casing. Patentee taught the device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." 270 F.2d at 813, 123 USPQ at 352.).

Rejection of claims 1-3 and 5-7 under 35 U.S.C. 103(a) as being unpatentable over *Bowden* in view of *Hautier* does not satisfy the above requirements. In view of the foregoing, currently amended independent claims 1-3 and 5-7 are patentably distinguishable over *Bowden* in view of *Hautier*. Notification to that effect is requested.

II. Claim 4 Rejection -- 35 USC §103. Claim 4 stands rejected under 35 U.S.C. 103(a) as being unpatentable over *Bowden* (884,702) in view of *Hautier* (3,787,066) as applied to claim 1 above, and further in view of *Henderson* (639,567). This rejection is traversed for the reasons state above for claim 1. In addition, claim 4 is properly dependent on claim 1 which is now allowable so that claim 4 is allowable. Notification to that effect is requested.

III. Reexamination and Allowance. In view of the foregoing, currently amended claim 1 is allowable together with originally presented claims 2-7 (properly dependent), currently presented independent claim 8, and currently presented dependent claims 9-13. Notification to that effect is requested. Reexamination and allowance are requested.

IV. Prior Art Made of Record. The prior art made of record and not relied upon has been reviewed and it does not describe or suggest the combination of elements presented in the claims as amended. The *Kellogg* patent, the *Conlon* patent, the *Haussels* patent, the *Cook* patent, the *Schlanger* patent, the *Patarchi* patent, and the French patent, whether consider alone or in combination with one or more of the other references, do not describe or suggest a "Motorcycle Wheel," as specified in the claims of the instant application.